

## **REMARKS**

### **I. Prosecution History**

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant cancelled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the Office Action, dated July 24, 2008, claims 1-13 were rejected and the amendments to claims 6 and 12 were not entered. The Examiner maintained the rejection to claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks. Applicant filed a Request for Continued Examination.

Under the non-final Office Action, dated December 3, 2008, the finality of the previous office action was withdrawn and amendments submitted by Applicant on August 28, 2008, were entered. Claims 1-13 were rejected as being unpatentable over Murren in view of Marks.

Under the current Office Action, made final, dated June 5, 2009, claims 1-6 and 9-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks. Applicant herein submits a Request for Continued Examination, along with amendments to the claims and new claims 16 and 17. Reconsideration and allowance of the application is respectfully requested.

### **II. Claim Rejections – 35 U.S.C. §103**

#### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and

evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a prima facie case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a prima facie showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a prima facie showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

### ***Murren in view of Marks***

Claims 1-6 and 9-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374) and the background of the invention.

Regarding claim 1, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing print-ready document library subject availability via multicast communication over a data network using a multicast communication transport layer; receiving subscriptions for print-ready document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites; and instantaneously, at time of repository change, synchronizing data representative of the print-ready document with remote subscribers at individual sites over the data network using a multicast communication transport layer.

However, while Murren fails to disclose a data network using a multicast communication transport layer, the Examiner argues that Marks discloses a data network using a multicast communication transport layer. And while neither Murren nor Marks teach print-ready document, this is well known in the art as evidenced by the background of the invention. Also, the Examiner argues that the background of the invention discloses already print formatted mater documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired. Therefore, the Examiner argues, it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed.

The Applicant respectfully disagrees with this assessment and traverses the rejection. Claim 1 is herein amended to recite "wherein said subscriptions comprise a configuration file that functions as a lookup table for subjects subscribed to by said subscribers" and "printing said print-ready document at said individual sites". Applicant submits that neither Murren, Marks, nor the background of Applicant's application disclose or suggest a configuration file that functions as a lookup table or printing said print-ready document at said individual sites. Thus, because Murren, Marks and the background all fail to disclose or suggest all of the limitations of Applicant's claim 1, the rejection fails to meet the requirements for *prima facie* obviousness as discussed above.

Further, Applicant submits that the rejection fails to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does, as also required for prima facie obviousness. The Examiner has merely provided a conclusory statements regarding a potential result achieved by Applicants' invention ("to have a one-to-many transmission protocol" and "to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed"), while no explicit analysis is advanced to explain how one having ordinary skill in the art would have been lead to deviate from the prior art at the time to provide for a multicast communication layer or to provide a print-ready document.

Applicant further submits that reasonable expectation of success is not advanced by the rejection because Marks teaches away from the general principles of Applicant's device, as does Murren. The teachings of Mark relate to delivery of a document or file upon request by a first computer (Marks paragraphs [0008-0010]), which is significantly different from the automatic delivery method of Applicant's device. In fact, Applicant's device specifically avoids the need to request a document, and instead provides automatic delivery of documents that are of particular interest to a user based on predefined subjects. Further, Murren discloses delivering of messages purely in electronic format (Murren, Paragraph 0057) and does not disclose or suggest that the messages be provided as print-ready documents for the express purpose of printing the documents to paper as the delivery method, as claimed by Applicant.

Applicants remind Examiner that the Federal Circuit held that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Therefore, it is unlikely that one having ordinary skill in the art at the time of invention would have been successful in modifying the teachings of Murren with the teachings of Marks to successfully achieve Applicant's device as claimed. The present invention contains elements not disclosed in the prior art, as well as utilizing publish-subscribe to deliver print-ready documents, not merely electronic messages as disclosed by

Murren. For these reasons, Applicant submits that the invention as a whole is not obvious. Based in the foregoing, Applicant submits that the rejection of claim 1 is traversed based on the above arguments and Applicant respectfully requests withdrawal of the rejection of claim 1.

Claims 2-6 and 9-15 are herein cancelled, thus rendering their rejection moot.

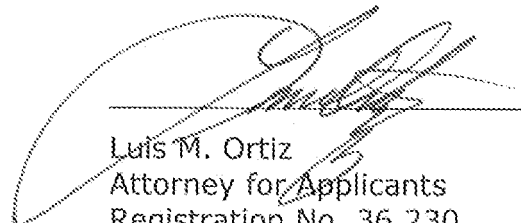
### III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action and a Request for Continued Examination is herein submitted. The Applicant has clarified the structural distinctions of the present invention and now respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative at 505-314-1311 to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

Dated: 10/1/2009

A handwritten signature in dark ink, appearing to read 'Luis M. Ortiz', is written over a horizontal line.

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